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EXAMINER

ESCALANTE, OVIDIO

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/513,646
Filing Date: February 25, 2000
Appellant(s): FORD ET AL.

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Leonard T. Guzman
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed November 12, 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Claimed Subject Matter*

The summary of claimed subject matter contained in the brief is correct.

(6) *Grounds of Rejection to be Reviewed on Appeal*

The appellant's statement of the grounds of rejection is correct.

New Ground(s) of Rejection

The Examiner has added a new ground of rejection in the rejection to claims 1,5 and 10, in response to applicant's new argument that the prior art reference Ordish disavows using a telephone to monitor discourse between callers. The Examiner added Gerszberg et al. US Patent 6,396,531 for showing support of video phones and video conferencing systems which receive advertisements and which can communicate across a packet based telephone network. This type of system uses non-conventional telephone methods and supports the fact that it was well known

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in the art that the packet based telephone network of Ordish uses at least a telephone network.

The Examiner's interpretation of conventional phones as described by Ordish include phones which do not allow supplementary data to be obtained while carrying on with a conversation.

Non-conventional phones include, but is not limited to, video-phones or phones that communicate across a packet based network or phones that allow supplementary data to be obtained during a conversation. The system of Ordish contemplates the use of packet networks and incorporates by reference several U.S. Patents which use of a telephone network system and receiving and making calls using the telephone network system.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 1,2,5,6,10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ordish US Patent 5,195,031 in view of Sawyer US Patent 6,351,279 or Gerszberg et al. US Patent 6,396,531.

Regarding claims 1,2,5,6,10 and 11, Ordish teaches a method, program storage device readable by a machine to perform the method steps and a system comprising means for interjecting messages into a real-time isochronous discourse between a plurality of users (abstract; col. 2, line 57-col. 3, line 32) comprising:

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providing a system (col. 3, lines 12-18; col. 5, lines 26-44) for accessing a real-time isochronous discourse on a video communication between two or more callers, (col. 5, lines 26-64);

accessing a real-time isochronous discourse on a video communication between two or more callers (col. 3, lines 12-18; col. 5, lines 44-64);

monitoring the discourse on the video communication between the callers to determine if the discourse relates to a message desired to be communicated to the callers by the system, (col. 3, lines 18-32; col. 5, lines 44-64; col. 10, line 63-col. 11, lines 17; abstract); and

communicating the desired message via the video communication to the callers when the discourse is determined to be related to the desired message, (col. 3, lines 1-32); and

continuing the above steps until the discourse being accessed is terminated by the callers or the system, (col. 3, lines 1-32).

Ordish teaches that it was well known to use landline connections in a telephone network for video communication and that two way conversations via the telephone was well known in the art, (col. 1, lines 32-59) and the message switching network 300 being implemented in a telephone packet network, (fig. 1). Ordish further suggests in col. 5, lines 51-55 that any type of video communication can be used. Ordish, however, does not specifically teach that the message-switching network 300 (fig. 1) is a telephone network and the video terminal (e.g. 410, fig. 1) is a telephone.

In the same field of endeavor, Sawyer teaches that it was well known in the art to communicate a desired message via a video telephone (“on a telephone”) to callers, (abstract; col. 1, lines 63-65; col. 2, line 63-col. 3, line 8).

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Also, in the same field of endeavor, Gerszberg et al. teaches that it was well known in the art that videophones can communicate across a packet network and display advertisements to parties during a call, (figs. 2,3A,15 and 16; col. 12, lines 66-col. 13, line 17). Gerszberg is also an example of a non-conventional telephone.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Ordish by including a telephone for making the call as taught and suggested by either Sawyer or Gerszberg so that any type of video communication can be used as suggested by Ordish and so that video telephone can be used to provide voice communication to the end users as taught by Sawyer and so that video conference can be easily established by dialing the conference's telephone number so that voice communication can be established between the end users.

2. Claims 3,4,7-9,12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sawyer US Patent 6,351,279 in view of Ordish US Patent 5,195,031.

Regarding claims 3,7 and 12, Sawyer teaches a method, system and program storage device readable by a machine, tangibly embodying a program of instructions executable by the machine to perform the method and a system comprising means for interjecting messages into a real-time isochronous discourse between a plurality of callers is provided (abstract; col. 1, line 63-65; col. 3, lines 29-52) comprising:

forming a system comprising:

a system interface for inputting and storing system parameters by an owner of the system, (col. 4, lines 8-32);

a communication media interface for communicating with a telephone system (video telephone system) being used by two or more callers, (col. 2, line 63-col. 3, line 8; fig. 3);

a database for storing system data including system messages to be transmitted to the callers, (col. 3, lines 9-28);

a caller interface for communicating the system data and/or messages to one or more of the callers, (col. 3, lines 9-8, col. 4, lines 33-50).

Sawyer does not specifically teach of a conversation analyzer and choosing a message based on the conversation.

In the same field of endeavor of video communications, Ordish teaches that it was well known in the art to have a conversation content analyzer and summarizer for determining if the communication on the video communication system between the callers is relevant to the system parameters, (col. 2, line 57-col. 3, line 32);

a database manager for matching system parameters with the communication on the video communication system between the callers, (col. 3, lines 12-18; col. 5, lines 26-64); and

accessing the video communication system being used by two or more callers using the communication media interface, (col. 3, lines 12-18; col. 5, lines 44-64);

monitoring the communication on the video communication system between the callers using the communication media interface, (col. 10, line 63-col. 11, line 17; col. 5, lines 44-64; abstract);

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analyzing the conversation on the video communication system using the conversation content analyzer and summarizer, (col. 3, lines 1-32; col. 5, lines 44-64);

determining if there is a match between the conversation on the video communication system and one or more of the system parameters using the database manager, (col. 5, lines 44-64);

sending the system data from the database to the database manager if there is a match and choosing a suitable message from the database for communication to the callers, (col. 3, lines 1-32; col. 10, line 63-col. 11, line 17; and

transmitting the message via the video communication system to the callers using the caller interface, (col. 3, lines 1-32).

The Examiner notes that since Ordish teaches that it was well known to use landline connections in the telephone network for video communication and since Sawyer teaches that the video communication is a video telephone communication then one skilled in the art would have used the well known teaching of monitoring video communications as shown by Ordish into the video communication (video telephony system) of Sawyer so that real-time messages can be sent to the end parties.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Sawyer by using a conversation analyzer to provide the callers with customized announcements based on their conversation as taught by Ordish so that the system can provide adaptive messages that is based upon the users interest and transactions based on their real-time conversation.

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Regarding claims 4,8,13, Sawyer in view of Ordish teaches that the isochroous discourse is a telephone call, (abstract, Sawyer).

Regarding claim 9, Sawyer teaches wherein different messages are provided to each caller, (col. 4, lines 7-22).

(10) Response to Argument

Issue I

As per claims 1 and 2:

Applicants contend that Ordish and Sawyer do not teach “monitoring the discourse *on the telephone* between the callers to determine if the discourse relates to a message desired to be communicated to the callers by the system since Ordish does not specifically teach that the discourse occurs via a telephone. The Examiner respectfully disagrees.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The Examiner did not rely upon Ordish for the teaching of having a discourse via a telephone but relied upon the teaching of a secondary reference (Sawyer) for this well-known teaching. Applicants state that Ordish teaches away from using a telephone as shown in col. 1, lines 327-43 of Ordish (Background of the Invention), and thus does not teach claim 1. The Examiner, acknowledges the statement by Ordish in that **conventional** telephone systems were at that time not capable of performing the above monitoring of the conversation and determining if the conversation relates to a message desired to be communicated to the callers. However, in

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light of Applicant's specification, and specifically in page 10, lines 21-23, Applicants specifically state that the preferred embodiment of their invention uses video telephones or video conferencing tools. Hence, Applicant's inventions employ the use of **non-conventional** phones.

Since the prior art reference Ordish in combination with Sawyer uses non-conventional phones to communicate then, the Examiner believes that the background art statement by Ordish and the teaching away statement by the Applicants do not apply since Ordish teaches that non-conventional (i.e. video conferencing tool and video phones) systems are capable of supplying supplementary data and performing the system, as claimed by the applicants, by using a video conferencing tool system. Thus, since Ordish suggests in col. 5, lines 51-55 that any type of video communication can be used and since video telephony reads on "in a telephone" then the claims read on the combination of the prior art references of Ordish and Sawyer.

Regarding claims 5,6,10 and 11:

Applicants contend that Ordish and Sawyer fail to teach or suggest "means for monitoring the discourse *on the telephone* between the callers to determine if the discourse relates to a message desired to be communicated to the callers by the system" and "means for communication the desired message *via the telephone* to the callers when the discourse is determined to be related to the desired message", since Ordish and Sawyer do not teach or suggest the claim 1 elements. The Examiner respectfully disagrees.

As stated above with claim 1, Ordish teaches of a video conferencing system which monitors the discourse between at least two video conferencing elements. Since video conferencing system is the same type of system that it preferred by the Applicants as stated in page 10, lines 21-23 of their specification and since the secondary reference Sawyer teaches that

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it was well known in the art that video conference systems can include a telephone then the Examiner believes that the current claims read on the prior art system of Ordish and Sawyer.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Ordish suggests in col. 5, lines 51-55 that any type of video communication can be used. Ordish also suggests of developing a system which capable of receiving supplementary data during a conversation. Since video telephony is able to provide both of these features, as shown in the prior art reference, then using the suggestion from Ordish and the teachings of Sawyer one of ordinary skill in the art would have been motivated to combine the teaching of Sawyer so that any type of video communication can be used as suggested by Ordish.

Therefore, the Examiner believes that since the claims do not preclude video telephones or video conferencing tools as used by the cited prior art references and since the claims read on the prior art then the rejection should be held.

Issue II

As per claims 3 and 4:

Applicants contend that Sawyer and Ordish, fail to teach or suggest “conversation content analyzer and summarizer for determining if the communication *on the telephone system* between the callers is relevant to the system parameters since Ordish does not teach “ a conversation

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content analyzer and summarizer for determining if the communication *on the telephone system* between the callers is relevant to the system parameters.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicants state that Ordish does not teach “a conversation content analyzer and summarizer for determining if the communication *on the telephone system* between the callers is relevant to the system parameters. However, the Examiner did not state in the Office Action that Ordish teach that the communication occurs on the telephone system. That limitation is relied upon by Sawyer who teaches of using a telephone system.

The examiner relied upon Ordish to teach that it was well known in the art to have a conversation content analyzer and summarizer for determining if the communication on the communication system between the callers is relevant to the system parameters as shown in col. 2, line 57-col. 3, line 32.

Applicants contend that Sawyer and Ordish fail to teach or suggest “monitoring the communication *on the telephone system* between the callers using the communication media interface since Ordish and Sawyer alone or in combination do not teach or suggest the claim 1 element “monitoring the discourse *on the telephone* between the callers to determining if the discourse relates to a message desired to be communication to the callers by the system”.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., monitoring the

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discourse *on the telephone* between the callers to determining if the discourse relates to a message desired to be communication to the callers by the system) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The Applicants are comparing independent claim 3 with independent claim 1. However, claim 3 does not pertain to using a telephone but the much broader term of communication media interface. Therefore, Applicant's argument to claim 1 does not provide sufficient basis for argument in claim 3.

Applicants contend that Sawyer and Ordish fail to teach or suggest "analyzing the conversation *on the telephone system* using the conversation content analyzer and summarizer" for similar reasons that they do not teach or suggest the feature of "a conversation content analyzer and summarizer for determining if the communication *on the telephone system* between the callers is relevant to the system parameters.

The Examiner respectfully disagrees, since, as stated above, the primary reference Sawyer sufficiently anticipates the use of a telephone system and Ordish was relied upon to teach the well-known and obvious feature of analyzing the conversation.

Since it is clear that both Sawyer and Ordish use a telephone system to connect to the "communication media interface(s)" then the Examiner believes that by using the teaching of analyzing the conversation and determining if the communication *on the telephone system* between the callers is relevant to the system parameters from Ordish then the claimed limitations as it currently stands reads on the cited prior art.

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As per claims 7,8,9,12 and 13:

Applicants contend that Sawyer and Ordish fail to teach or suggest the “means for forming a system”, the communication *on the telephone system* between the caller is monitored using the communication media interface and “the conversation *on the telephone system* is analyzed using the conversation content analyzer and summarizer.” element since the Sawyer and Ordish do not teach or suggest the elements of claim 3. However, as stated above, in the response to claim 3, the Applicants are arguing the references separately and the Examiner is relying upon Ordish only for the well-known teach of monitoring a conversation using a communication media interface which is sufficiently taught by Ordish.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

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February 22, 2005

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